

REMARKS

Claim Amendments

Applicants presently cancel system claims 7-12 and computer program product claims 13-18, leaving only method claims in the present application. In amending the claims in the present application, Applicants do not concede that the claims as originally filed were not in a condition for allowance nor do these cancellations represent a disclaimer of the recited subject matter. Rather, Applicants reserve the right to pursue these cancelled system and product claims in one or more continuation applications. Applicants believe themselves entitled to pursue these claims in additional applications because the system and product claims are directed to an invention in a different statutory category than are the method claims that remain in this application. Applicants believe they are entitled to have claims directed to inventions in separate statutory categories issued in separate patents.

Applicants presently amend claim 1 to include limitations previously found in dependent claims 2-6. As such, Applicants have cancelled claims 2-6 in this Response. Applicants submit that the amendments do not introduce any new matter into the specification and submit that the claims are in condition for allowance.

Claim Rejections – 35 U.S.C. § 102 over Teller

In the Office Action, claims 1, 7, and 13 stand rejected under 35 U.S.C. § 102 as being anticipated by Teller, *et al.* (U.S. Publication No. 2002/0019586) (hereafter, 'Teller'). As discussed above, claims 7 and 13 are cancelled in this Response. To anticipate remaining claim 1 under 35 U.S.C. § 102, Teller must disclose and enable each and every element and limitation recited in the claims of the present application. As presently amended, claim 1 includes limitations previously found in dependent claims 2-6 of Applicants' original application. The Office Action admits at pages 4-6 that Teller does not disclose each and every element and limitation found in dependent claims 2-6 of Applicants' original application. The limitations of former claims 2-6 are now recited in newly

amended claim 1 – so that Teller can no longer be said to disclose all the elements of claim 1. Because Teller does not disclose and enable each and every element and limitation of amended claim 1, Teller does not anticipate claim 1 of the present application. The rejection of claim 1 under 35 U.S.C. § 102 should therefore be withdrawn.

Claim Rejections – 35 U.S.C. § 103 Over Teller And Miller

In the Office Action, claims 2-6, 8-12, and 14-18 stand rejected for obviousness under 35 U.S.C. § 103 as being unpatentable over Teller in view of Miller, *et al.* (U.S. Publication No. 2004/0030531) (hereafter, ‘Miller’). As discussed above, claims 2-18 are cancelled in this Response, and the limitations previously found in claims 2-6 have been incorporated into claim 1 by amendment. The question of whether remaining claim 1 in the present application is obvious or not is examined in light of: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of others. *KSR Int’l Co. v. Teleflex Inc.*, No. 04-1350, slip op. at 2 (U.S. April 30, 2007). Although Applicants recognize that such an inquiry is an expansive and flexible one, the Office Action must nevertheless demonstrate a prima facie case of obviousness to reject Applicants’ claim for obviousness under 35 U.S.C. § 103(a). *In re Khan*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). To establish a prima facie case of obviousness, the proposed combination of references must teach or suggest all of Applicants’ claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Independent claim 1 of the present application, as currently amended, recites:

1. A method for administering devices in a network, the method comprising:

creating a user metric vector comprising a plurality of disparate user metrics, wherein each user metric represents an indication of a

dynamic change in a user's physical condition in response to an external stimulus, wherein the user is a person;

creating a user metric space comprising a plurality of metric ranges;

determining whether the user metric vector is outside the user metric space;

if the user metric vector is outside a user metric space, identifying an action in dependence upon the user metric vector, wherein the action administers a device to alter the user's physical condition in response to the external stimulus;

receiving an allowed action list;

determining whether the action is allowed, wherein determining whether the action is allowed comprises comparing the identified action with the allowed action list;

if the action is allowed, executing the action; and

identifying an allowed replacement action, if the identified action is not allowed, wherein identifying an allowed replacement action comprises comparing the identified action with the allowed action list, further comprising executing the allowed replacement action.

As discussed in more detail below, the cited references do not teach or suggest each and every element and limitation of claim 1 of the present application. As such, the cited references cannot be used to establish a prima facie case of obviousness against claim 1 of the present application.

**The Combination Of Teller And Miller Does Not Teach
Or Suggest Determining Whether The Action Is
Allowed As Claimed In The Present Application**

Claim 1 of the present application is currently amended to include the following limitation previously found in claim 2 of Applicants' original application: determining whether the action is allowed, wherein determining whether the action is allowed comprises comparing the identified action with the allowed action list. The Office Action at page 4 takes the position that Miller at paragraphs 0042-0046, 0049, 0055, and 0057 teaches or suggests the limitations of former claim 2 which are now included in amended claim 1 of the present application.

Applicants' respectfully note in response, however, that what Miller at the cited reference points discloses is a client agent and a home agent that monitor and manage information relating to the actor and the actor's environment. Miller further discloses a domain agent that creates initial response plans. Miller's domain agent selects a plan from a library of plans that describe the behavior of the actor. Miller's client agent, home agent, and domain agent, however, do not teach or suggest determining whether the action is allowed, wherein determining whether the action is allowed comprises comparing the identified action with the allowed action list as claimed in the present application because Miller does not teach or suggest comparing the identified action with the allowed action list. Applicants' original specification states that in some situations a particular action may be available for execution, but for one reason or another, it has been determined that the action should not be executed. See, Applicants' original application at page 72, lines 5-15. To address such a situation, an identified action is compared to an allowed action list according to the claims of the present application. In contrast to Applicants' claims, Miller does not teach or suggest such a comparison. Miller merely discloses creating an initial response plan without teaching or suggesting that such a response plan is compared to an allowed action list. Because Miller does not teach or suggest determining whether the action is allowed, wherein determining whether the action is allowed comprises comparing the identified action with the allowed action list as claimed in the present

application, the proposed combination of Teller and Miller does not teach or suggest each and every element and limitation of the claims of the present application. As such, the proposed combination of Teller and Miller cannot be used to establish a prima facie case of obviousness against the claim 1 of the present application.

In addition to the fact that Miller does not teach or suggest determining whether the action is allowed, wherein determining whether the action is allowed comprises comparing the identified action with the allowed action list, for identical reasons, Miller also does not teach or suggest the following limitations of claim 1 in the present application:

- receiving an allowed action list
- identifying an allowed replacement action, if the identified action is not allowed, wherein identifying an allowed replacement action comprises comparing the identified action with the allowed action list, further comprising executing the allowed replacement action

Every limitation cited above recites an allowed action list. Because neither Teller nor Miller teaches or suggests an allowed action list, the proposed combination of Teller and Miller cannot teach or suggest any of the limitations above. Because the combination of Teller and Miller does not teach or suggest each and every element and limitation of Applicants' claim, the combination of Teller and Miller cannot be used to establish a prima facie case of obviousness against claim 1 of the present application. The rejection of claim 1 under 35 U.S.C. § 103 should be withdrawn and the claim should be allowed.

**The Office Action Does Not Examine
Applicants' Claims Pursuant To *Graham***

In addition to the fact that the Office Action has not established a prima facie of obviousness there is another reason that the rejection of claim 1 should be withdrawn: The Office Action does not examine Applicants' claims in light of the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The question of

whether Applicants' claims are obvious or not is examined in light of: (1) the scope and content of the prior art; (2) the differences between the claimed invention and the prior art; (3) the level of ordinary skill in the art; and (4) any relevant secondary considerations, including commercial success, long felt but unsolved needs, and failure of others. *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, slip op. at 2 (U.S. April 30, 2007); *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). "To facilitate review, this analysis should be made explicit." *KSR*, slip op. at 14 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). That is, the Office Action must make explicit an analysis of the factual inquiries set forth in *Graham*. In the present case, however, the Office Action does not even mention the factual inquiries set forth in *Graham*. As such, the rejection of claim 1 under 35 U.S.C. § 103 is improper and should be withdrawn.

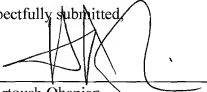
Conclusion

Claim 1 stands rejected under 35 U.S.C. § 102 as being anticipated by Teller. As shown above, Teller does not disclose each and every element and limitation of claim 1 of the present application. The rejection of claim 1 under 35 U.S.C. § 102 should therefore be withdrawn and the claim should be allowed. Applicants respectfully request reconsideration of claim 1 of the present application.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

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By:

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